

STATUS OF THE CLAIMS

Claims 1-15 are pending in the Application.

Claims 1-15 stand rejected by the Examiner.

Claims 16 and 17 have been canceled, without prejudice, herein.

REMARKS

Reconsideration of the present Application is respectfully requested.

Supplemental Office Action

Applicant thanks Examiner for conducting a phone interview on March 14, 2006, and for correcting the status of the Application in a supplemental office action, mailed March 27, 2006, to indicate that the action was *non-final*.

Claim Rejections Pursuant to 35 U.S.C. § 102

Claims 1-8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Gartner (U.S. Patent No. 5,284,363). Claims 1-8 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Bernier (U.S. Patent No. 6,637,775). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. § 102 recites, in part:

A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent ...

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on

sale in this country, more than one year prior to the date of the application for patent in the United States...

Consistently, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See, M.P.E.P. §2131 citing Verdegaaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).*

Applicant again respectfully submits that the present Office Action misconstrues the teachings of the cited references of record, specifically in the recitation in the Office Action that Gartner and Bernier teach a labeling apparatus having at least one predefined tearing region within the first and second substantially planar members suitable to access a corresponding portion of the product, as is recited in Applicant's independent Claim 1.

Regarding the teaching of Gartner, the present Office Action states that Gartner teaches "one predefined tearing region 39 within the edges of both members 20 and 10/40 (Fig 1) where region 39 includes perforations and is suitable for being partially and/or torn fully (c 4, L 31-37)" (present Office Action at page 2, point 2). In contrast to this, Gartner actually teaches:

The **layer 10 of the label 8** may optionally be provided with either perforations or scores 39 (FIG. 1) such that the portion defined by the dotted lines 39, may be completely separated from the label 8 if for instance, a discount coupon is printed on the inner surface 28 of the layer 10.

(Gartner at Col. 4, lines 31-37, emphasis added)

From this, it should be readily apparent that Gartner teaches that ***only*** layer 10 (the top layer) of label 8 may contain perforations or scores 39, such that the portion defined by the dotted lines 39 may be separated from the label 8 to create a separable coupon printed on the inner surface of the removed portion of layer 10. It is important to note that ***nowhere*** does Gartner teach the bottom layer 20, which is permanently adhered to the container, containing any

sort of perforation or tearing region. Therefore, regardless of whether there are perforations in the top layer, if there are no perforations in the bottom layer, the perforations in the top layer cannot be used to access a portion of any product around which the entire label apparatus is secured, as required by Applicant's claims.

The same is true of Bernier. The present Office Action states that Bernier teaches "one predefined tearing region 42 within the edges of both members 14 and 12 (Fig 3) where region 42 includes perforations and is suitable for being partially and/or torn fully (c 3, L 40-49)." This is simply not what Bernier says. Bernier teaches the following:

In other cases, it is desirable to permit the complete removal of the top ply 12 of the two-ply label. For example, the pharmacist can easily remove the top ply of the two-ply label and adhere it directly to documents in the patient's file. For such applications, the top ply is provided with a perforated line 42, adjacent the edge permanently adhered to the bottom ply. This permits the top ply 12 to be easily peeled back and torn away from the bottom ply 14 along perforated line 42.

(Bernier at Col. 3, lines 40-49, emphasis added)

Thus, in stark contrast to the teaching of Bernier referred to in the present Office Action, Bernier actually teaches only that a perforation in the top layer is for removal of the top layer from the bottom layer, which bottom layer remains fully intact and fully adhered to the container. As was true with Gartner, regardless of whether there are perforations in the top layer, if there are no perforations in the bottom layer, the perforations in the top layer cannot be used to access a portion of any product around to which the entire label apparatus is secured.

Applicant would also like to point out that the at least one tearing region, as claimed, is suitable for being partially torn to access a corresponding *portion* of the **product**. The Examiner presumes that this product is a cylindrical bottle or container (present Office Action at page 6,

point 6), but Applicant respectfully submits that “containers” are not composed of portions that are removable, other than the cap of the container, and as such the “product” in Applicant’s claims is the actual medical pills or the like, and not a container for such pills.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102 (a) and (b) rejections of claim 1, as both Gartner and Bernier fail to teach the invention recited in claim 1. Further, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102 (a) and (b) rejections of claims 2-8, as each of these claims ultimately depend on a patentably distinct independent base claim 1.

Claim Rejections Pursuant to 35 U.S.C. § 103

Claims 9-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gartner (U.S. Patent No. 5,284,363), as well as over Bernier (U.S. Patent No. 6,637,775). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. § 103(a) recites, in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For at least the reasons stated above, the cited references, either separately or in combination, do not teach or suggest each of the limitations of independent Claim 1.

Specifically, as previously explained, neither Gartner nor Bernier teach a labeling apparatus having at least one predefined tearing region within the first and second substantially planar members suitable to access a corresponding portion of the product. Accordingly, Applicant submits at least Claim 1 is patentably distinguishable over the art of record. Further, Applicant submits that dependent claims 9-15 are likewise in a condition for allowance by virtue of their ultimate dependence on a patentably distinct base Claim 1.

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CONCLUSION

Wherefore, Applicant believes that all outstanding grounds raised by the Examiner have been addressed and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully Submitted,



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